

OFFICIAL

PATENT

Docket No. 220.00010150

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s): Eric T. Kool)
Serial No.: 09/997,931)
Confirmation No.: 5355)
Filed: November 30, 2001)
For: CIRCULAR DNA VECTORS FOR SYNTHESIS OF RNA AND DNA)

Group Art Unit: 1635
Examiner: Sean McGarry

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Mail Stop Amendment

Commissioner for Patents

Attn: Examiner Sean McGarry

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May 5, 2004
Date

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| Serial No.: 09/997,931 |) | Examiner: | Sean McGarry |
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| |) | | |
| For: <u>CIRCULAR DNA VECTORS FOR SYNTHESIS OF RNA AND DNA</u> | | | |

SUPPLEMENTAL RESPONSE TO THE
RESTRICTION REQUIREMENT

Commissioner for Patents
Mail Stop Amendment
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

In further response to the Office Action mailed February 23, 2004, please consider the following remarks.

Supplemental Response

Serial No.: 09/997,931

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Filed: November 30, 2001

For: CIRCULAR DNA VECTORS FOR SYNTHESIS OF RNA AND DNA

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Remarks

In response to the Restriction Requirement mailed February 23, 2004, and supplemental to the Response to the Restriction Requirement transmitted March 22, 2004, Applicant affirms the election of Group I (including species election of a mammalian cell), with traverse.

The Examiner has grouped the invention into three groups:

- I. Claims 96-115, 117 and 119-122, drawn to a method of synthesizing an RNA oligonucleotide in a cell
- II. Claims 96, 97, 99-116, 118, 119, 120, 122 and 123, drawn to a method of nucleic acid based treatment in an animal; and
- III. Claims 96, 97, 100-115, 117, 122 and 123, drawn to a method of RNA expression in a plant.

Applicant requests reconsideration and withdrawal or modification of the Restriction Requirement for the following additional reasons.

Applicant submits that restriction of the invention is improper as it does not significantly reduce the search burden, particularly in view of the fact that the linking claim(s) will need to be searched. Alternatively, it is submitted that the restriction should be modified as explained below.

Claims 116 and 118 recite "implanting the cell *into a plant or animal*" and thus should be included in both Groups II and III.

Claim 117 is directed to the method performed in a cell *explanted* from a plant or an animal. As such, claim 117 should be included in Group I only and excluded from Group III. Claim 120, which depends from claim 117, should be included in Group I only and excluded from Group II because it recites the type of animal (i.e., a mammal) from which the cell is explanted.

Claim 119 depends from claim 118, reciting the origin of the cell that is implanted into the *plant or animal*. Claim 119 should thus be included in both Groups II and III.

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Claim 122 recites a living organism and should therefore be included in Groups II and III. Claim 123, which depends from claims 122, should likewise be included in Groups II and III.

In summary, it is requested that the restriction requirement be reconsidered and withdrawn, or be modified as follows:

Claim 116 is generic to Groups II and III and should be added to Group III.

Claim 117 is properly included only in Group I and should be removed from Group III.

Claim 118 is generic to Groups II and III and should be added to Group III.

Claim 119 is generic to Groups II and III and should be added to Group III.

Claim 120 is properly included only in Group I and should be removed from Group II.

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Summary

The Examiner is invited to contact Applicant's Representatives, at the below-listed telephone number, if it is believed that prosecution of this application may be assisted thereby.

Respectfully submitted for
Eric T. Kool

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CERTIFICATE UNDER 37 CFR §1.8:

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By: S. E. OlsenName: S. E. OLSEN